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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,396	03/28/2007	Marc Chaussade	1004900-000278	8991

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BUCHANAN, INGERSOLL & ROONEY PC  
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EXAMINER
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LOEWE, ROBERT S

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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03/11/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
offserv@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,396	<b>Applicant(s)</b> CHAUSSADE ET AL.	
	<b>Examiner</b> ROBERT LOEWE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-17 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/23/06 and 10/19/09</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 9 recites the limitation "-C- the crosslinking catalyst according to the invention". This limitation is indefinite. For purposes of further examination, it will be assumed that the limitation "-C- the crosslinking catalyst according to the invention" refers to the limitations of the crosslinking catalyst C of instant claim 1. Applicants are required to further limit component (C) of instant claim 9 in order to overcome this rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7 and 9-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chadha et al. (US Pat. 3,664,997).

Claims 1-3 and 17: Example 21 of Chadha et al. teaches the preparation of silicone elastomers. The silicone elastomers are prepared by mixing a hydroxy-terminated polysiloxane, a crosslinker (ethyl orthosilicate), a filler, and specific crosslinking catalysts, including

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bis(dibutyltin laurato)oxide, which satisfies the limitations of instant claims 1-3. Chadha et al. further teaches and claims that the organopolysiloxane may also bear hydrolyzable alkoxy groups (2:60-62 and claim 1). Bis(dibutyltin laurato) oxide has the molecular formula  $C_{40}H_{82}Sn_2O_5$ , which has a molecular weight of approximately 880.5 g/mol. Table I of Chadha et al. shows employing this catalyst at amounts of 0.05, 0.10, 0.30, 0.50, 0.75 and 1.00 part per 100 parts of the remaining ingredients. Using 100 parts as being 100 g, the following amounts of catalyst are taught to be added according to the manner required by instant claim 1: 0.05 parts = 0.057 mmol per 100 g of the composition; 0.1 parts = 0.114 mmol per 100 g of the composition; 0.30 parts = 0.34 mmol per 100 g of the composition. All three amounts satisfy the amount of catalyst required by instant claim 1. When bis(dibutyltin oleato)oxide, whose structure satisfies instant claim 1, and whose formula weight is approximately 1044 g/mol, is employed at 0.30 parts, the amount of catalyst added according to the manner required by instant claims 1 and 2 is 0.28 mmol, which falls within the ranges of instant claims 1 and 2. The limitation "which is stable on storage in the absence of moisture and which crosslinks in the presence of water to give an elastomer" is inherent to the compositions taught by Chadha et al. given that Chadha et al. expressly teaches the composition of instant claim 1. A chemical composition and its properties are inseparable.

Claim 7: The organotin catalysts of example 21 are employed as the sole crosslinking catalysts.

Claim 9: Example 21 of Chadha et al. teaches the preparation of silicone elastomers. The silicone elastomers are prepared by mixing a hydroxy-terminated polysiloxane, an adhesion promoter/crosslinking agent (ethyl orthosilicate), iron oxide filler, and specific crosslinking

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catalysts, including bis(dibutyltin laurato)oxide and bis(dibutyltin oleato)oxide, which satisfies the limitations of component C of instant claim 9. Chadha et al. further teaches and claims that the organosilane may also bear hydrolyzable alkoxy groups (2:60-62 and claim 1). The exemplified viscosities of the organopolysiloxanes fall with that required for component A of instant claim 9.

Claims 10-15: Chadha et al. exemplifies tetraethylorthosilicate which is an organosilicon compound which fully satisfies the limitations of instant claims 10-15.

Claim 16: The working examples of Chadha et al. all contain an adhesion promoter and are all taught to be cured to a silicone elastomer, thereby satisfying instant claim 16.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chadha et al. (US Pat. 3,664,997), as applied to claim 1 above.

While Chadha et al. does not explicitly teach employing mixtures of at least two different organotin catalysts as required by instant claim 8, Chadha et al. does exemplify at least two organotin curing catalysts which satisfy formula (C) of instant claim 1 [bis(dimethyltin oleato)oxide and bis(dibutyltin laurato)oxide. Both are taught to be added for the same purpose (i.e., a curing catalyst). In such instances, it is not inventive to combine two ingredients which are taught to have the same exact function, in order to form a new composition in which a mixture of the two ingredients are present. Moreover, the courts have stated that “It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Further, Applicants do not appear to show any unexpected results, such as a synergistic effect, when combining two or more of the tin curing catalysts according to the invention.

#### ***Relevant Art Cited***

Additional prior art documents which are relevant to Applicants invention can be found on the attached PTO-892 form.

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***Allowable Subject Matter***

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, neither Chadha et al., which is believed to represent the closest prior art, nor any of the references of record teach or suggest the specific organotin curing catalysts of instant claims 4-6.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Robert Loewe/

Patent Examiner, Art Unit 1796

5-Mar-10